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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,936	01/18/2001	Roland Eberlein	4965-000114	9936

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EXAMINER

ODLAND, KATHRYN P

ART UNIT PAPER NUMBER

3743

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,936

Applicant(s)

EBERLEIN ET AL.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

A novel feature of the invention should be included in the title.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not understood as to the scope of the term "loss-proof." The specification does not adequately define what is "loss-proof." Any art rejection is as best understood.

4. Claims 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood as to the scope of the term "form-locking." The specification does not adequately define what is "form-locking." Any art rejection is as best understood.

Claim Objections

5. Claim 1 is objected to because of the following informalities: it appears there is a typographical error in the last line of the claim. The term "in" appears twice.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoffer et al. in US Patent No. 4,971,497.

Stoffer et al. disclose a fastening assembly having:

- A fixing element (65) to be fastened to a substructure where the fixing element has at least one bore, as seen in figure 5
- At least one screw (64) which can be passed through the at least one bore of said fixing element, and which can be screwed into said substructure, said screw having a shaft and a head, as seen in figures 5-8
- At least one bushing (67) arranged in said at least bore, through which said screw can be passed for screwing said screw into said substructure, said bushing being able to swivel in several spacial directions when seated in said bore, said bushing further comprising a seat for at least partially receiving at least a partial surface of said head of said screw, as recited in column 4, lines 50-68, column 5, and seen in figures 5-8

Wherein an inner surface of said bore and an outer surface of said bushing are formed to be about spherically curved, such that a region of largest diameter of said inner

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surface and said outer surface is situated between an upper edge and a lower edge of said bore, wherein said bushing is loss-proof pressed in [in] said bore.

With respect to the "wherein" clause, it has been held that the functional "whereby" and "wherein" statements do not define any structure and accordingly cannot serve to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957). Functional language is not given patentable weight in apparatus claims. Nonetheless, Stoffer et al. disclose an inner surface of said bore and an outer surface of said bushing are formed to be about spherically curved, such that a region of largest diameter of said inner surface and said outer surface is situated between an upper edge and a lower edge of said bore, as seen in figure 5. Furthermore, it can be considered that the bushing is "loss-proof" since the current application specification does not define "loss-proof"

Regarding claim 2, Stoffer et al. disclose a symmetry axis of said bushing that can be swiveled preferably over an entire azimuth angle of 360.degree. in an angular range of 0.degree. to at least 45.degree. with respect to a symmetry axis of said bore, as discussed in column 5 and seen in figures 5-8.

Regarding claim 3, Stoffer et al. disclose a bushing that is mounted directly in said bore, as seen in figures 5-8.

Regarding claim 4, Stoffer et al. disclose a bushing that is received in said bore in form-locking manner. It can be considered that the bushing is "form-locking" since the current application specification does not define "form-locking."

Regarding claim 5, Stoffer et al. disclose a bushing that is received to be swiveled in said bore through a bearing element (such as 83), which can be fixed to said fixing element and which is arranged in said bore, and wherein in this case an inner surface of said bearing element is about spherically curved, such that a region of largest diameter of said inner surface and said outer surface is situated between an upper edge and a lower edge of said bearing element, wherein said bushing is *loss-proof* pressed in said bearing element, as described in column 4, lines 50-68, column 5 and seen in figures 5-8.

Regarding claim 6, Stoffer et al. disclose a head of said screw and said seat of said bushing form a substantially form-locking connection. It can be considered that the bushing is "form-locking" since the current application specification does not define "form-locking."

Regarding claim 7, Stoffer et al. disclose a head of said screw and said seat of said bushing are formed conically to be complimentary to one another, as seen in figures 5-8.

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Regarding claim 8, Stoffer et al. disclose an upper edge of said seat of said bushing that is rounded, as seen in figures 5-8. The claim does not limit the direction in which the bushing is rounded. Therefore, given a reasonably broad interpretation of the term "rounded," the top of the bushing is rounded in a circumferential direction as seen in figures 5-8.

Regarding claim 9, Stoffer et al. disclose a periphery of said head of said screw is configured as a support surface, which in the tightened condition of said screw rests against a support surface of said bushing formed to be approximately complimentary to said support surface of said head, as recited in column 4, lines 50-68, column 5 and seen in figures 5-8.

Regarding claim 10, Stoffer et al. disclose a bushing that has **approximately** the same height as said bore, and wherein said head of said screw has approximately the same height as said seat of said bushing, as seen in figures 5-8.

Regarding claim 11, Stoffer et al. disclose a bushing that is **integrally formed of metal or of synthetic material**, or comprises a metal body with said seat of said bushing then being at least partially coated with synthetic material, as recited in column 3, lines 18-33.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoffer et al. in US Patent No. 4,971,497.

Stoffer et al. disclose the invention with the exception of explicitly reciting securing a bone fracture in a human body, wherein said fixing element is a rigid plate or a rigid brace and said at least one screw is a bone screw or mounting an object on a wall, wherein said fixing element is comprised in the group of a wall fixture, a profile or the like, or for assembling furniture or the like, wherein said fixing element is comprised in the group of an armature, a hinge, an angle or the like. However, this language is intended use, wherein it would be obvious to one with ordinary skill in the art to use the invention of Stoffer et al. in a bone fracture in the human body or in a wall. The specification does not recited the criticality of the invention in use in any particular way, therefore, the intended use is not given patentable weight for it does not define structure.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US 2002/0082603; US Patent No. 4,038,801; and US Patent No. Re. 36,164.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO



Henry A Bennett
Supervisory Patent Examiner
Group 3700